

REMARKS

In the Office Action mailed on September 29, 2005, the Examiner has required restriction under 35 U.S.C. 121 to one of the following groups:

- I. Claims 1-26, drawn to products of Formula (I) wherein C-N is the cyclometallated ligand 2-phenylpyridine; and X and Y are each optionally substituted pyrazole, classified in class 546, subclass 2+.
- II. Claims 1-7, 9-17 and 20-26, drawn to products of Formula (I) not embraced by Group I, classified in classes 546 and 548.
- III. Claims 27-43, drawn to a light emitting device comprising products of Formula (I) wherein C-N is the cyclometallated ligand 2-phenylpyridine; and X and Y are each optionally substituted pyrazole, classified in class 313, subclass 483+.
- IV. Claims 27-30, 32, 35-37, and 39-43 drawn to a light emitting device comprising products of Formula (I) not embraced by Group IV, classified in class 313.

Applicants elect Group I, with traverse, for prosecution in this application. However, it is respectfully submitted that the Restriction Requirement between Group I and Group II is improper and should be withdrawn for the following reasons.

In support of the Restriction Requirement, the Office Action states that the inventions of Groups I and II are distinct from each other. However, restriction under 35 U.S.C. § 121 can be made only if two inventions are *both* independent and distinct. "Independent," as defined in the M.P.E.P. (for purposes of restriction practice) means that "there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the

process are independent inventions.” M.P.E.P. § 802.01. It is respectfully submitted that the inventions of Groups I and II are not independent because Groups I and II are species within the genus of Claim 1 and are taught in the instant application for use as the emissive material in an organic light emitting device, the inventions are connected in design, operation or effect. Applicants believe that Group I and Group II are sufficiently related as to form a single general inventive concept, and therefore request that the restriction between these groups be withdrawn.

Section 802.01 of the M.P.E.P. provides the following explanation of the term “distinct” in this context:

Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable (novel and nonobvious) over the other (though they may each be unpatentable over the prior art). (Emphasis in original).

Thus, according to section 802.01 of the M.P.E.P. related inventions are distinct if the inventions *as claimed* are not connected in design, operation or effect and when one of the inventions is patentable over the other. The M.P.E.P. instructs the Examiner to look to the inventions *as claimed*, as opposed to the case here, where the inventions of Group I and Group II do not reflect the invention as claimed, but rather seek to improperly split the generic claims.

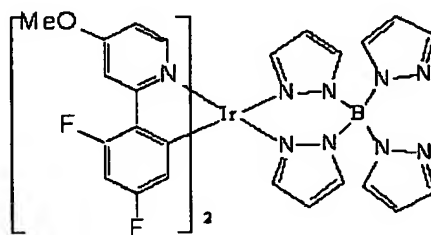
The Restriction of Group I and Group II that the Examiner proposes appears to be better treated as solely a requirement for the election of a species, as Group I is a species within the scope of Claim 1. Applicants respectfully submit that the M.P.E.P. addresses the restriction of an individual claim in the narrow case of a Markush-type claim that recites a plurality of alternatively usable substances or members, which is more properly termed an election of species requirement. M.P.E.P. 803.02. Applicants note that Groups I and II as defined by the

Examiner do not represent the division between members of a Markush group. The M.P.E.P. further provides that “in applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the Examiner may require a provisional election of species prior to examination on the merits.” M.P.E.P. 803.02. Thus, Section 803.02 of the M.P.E.P. does not suggest that the Examiner divide the Markush-type claim in the manner of her choosing, but rather states that the Examiner should require the Applicants to elect a species for prosecution on the merits. Following the election of species, “the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.” M.P.E.P. 803.02. Thus, Applicants respectfully submit that the Restriction of the claims into Group I and Group II is improper, and is more properly addressed by the requirement for an election of a species for prosecution on the merits. Further, when the species is found allowable, the full scope of the claim must be examined.

Applicants respectfully submit that the examination of Group II together with Group I would not impose a serious burden on the Examiner. Indeed, the Restriction Requirement itself notes that these compounds are classified, at least in part, in the same class (class 546). Applicants believe that it would not place an undue burden on the Examiner to search using the PTO’s classification system for art related to the claims of Groups II while conducting a search for art related to the claims of Group I. Accordingly, Applicants respectfully request that Groups I and II be examined together.

For the above reasons, Applicants respectfully submit that the restriction of Group I and Group II is improper and applicants respectfully request that the restriction of Group I from Group II be withdrawn.

The Examiner also requires the Applicants to elect a single disclosed species for prosecution on the merits, to which the claims of the present application shall be restricted if no generic claim is finally held to be allowable. Applicants further provisionally elect the species of Example 1 found on page 28, which is reproduced below:



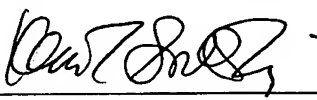
(MeOppy)Ir(pz₂Bpz₂)

Applicants respectfully request that, upon the allowance of a generic claim, claims directed to non-elected species including all the limitations of the generic claim be considered, in accordance with 37 C.F.R. § 1.141, and ultimately allowed.

If for any reason the Examiner believes that prosecution of this application would be advanced by contact with the Applicants' attorney, the Examiner is invited to contact the undersigned at the telephone number given below.

Dated: October 31, 2005

Respectfully submitted,
KENYON & KENYON

By: 
Kevin T. Godlewski
Reg. No. 47,598

KENYON & KENYON
One Broadway
New York, NY 10004
Direct Dial: 212-908-6203
Fax: 212-425-5288
General Tel: 212-425-7200